

REMARKS

This application has been carefully reviewed in light of the Office Action dated May 9, 2005. Claims 20 and 25 to 35 are pending in the application, of which Claims 32 to 35 have been newly-added. Claims 20, 28 and 32 are the independent claims herein. Favorable review and early passage to issue are respectfully requested.

The Office Action reiterated an objection to the drawings with regard to features of Claim 19 allegedly not being depicted in the drawings, despite the fact that Claim 19 was cancelled. Thus, the objection is moot since Claim 19 is no longer pending in the application. Accordingly, withdrawal of the objection is respectfully requested.

Claims 20 and 25 to 31 were rejected under 35 U.S.C. § 112, second paragraph for allegedly improper syntax in the claim language. Without conceding the propriety of the rejections, the claims have been reviewed and amended as Applicants deem appropriate so as to provide better syntax and fully compliance with § 112, second paragraph. Accordingly, withdrawal of the rejections is respectfully requested.

Claims 20 and 25 to 31 were rejected under 35 U.S.C. § 103(a) over U.S. Publication No. 2002/0038348 (Malone) in view of Official Notice taken by the Examiner. The rejections are traversed and reconsideration and withdrawal thereof are respectfully requested.

Initially, it is noted that the Office Action alleged that Applicant did not properly traverse the Official Notice and therefore, the Official Notice was deemed conceded. This assertion is clearly contrary to Applicant's comments made in the January 28, 2005 Amendment. Specifically, it was argued that the Official Notice based on "common knowledge" taken in the Office Action failed to meet the requirements for establishing obviousness since, in accordance with the Federal Circuit's holding in *In re Lee*, the Office Action failed to provide any evidentiary support for the alleged common knowledge. Thus, not only did Applicant traverse the Official Notice, but Applicant

presented legal arguments as to the deficiency of the rejection made in the Office Action and requested that the Examiner provide such evidentiary support so as to meet the requirements of *In re Lee*. Nonetheless, despite Applicant's clear traversal of the Official Notice, the Examiner inexplicably deemed the Official Notice as conceded and also failed to provide the necessary evidentiary support. Thus, Applicant has conceded nothing and as set forth below, the Official Notice is again traversed.

Turning now to the claimed invention, the present invention concerns providing compensation to consumable traders in an online shopping system. According to the invention, a status of use of at least one consumable used in a printing device is received by a sever function via a communication line. A service point is calculated according to the received status, and when a customer purchases merchandise provided by a consumable trader based on the calculated service point, information on the customer's purchase is recorded in a storage unit. Then, compensation to the consumable trader is decided based on the information recorded in the storage unit.

Referring specifically to the claims, amended independent Claim 20 is an online shopping method executed in a system having a server function of managing a status of use of at least one consumable used upon printing in a printing device, the method comprising receiving the status of the use of the at least one consumable used in the printing device via a communication line by the server function, calculating a service point according to the received status of the use of the at least one consumable, causing a storage unit to record information on a customer's purchase of merchandise provided by a consumable trader, the purchase being based on the calculated service point, and deciding a compensation to the consumable trader based on the information recorded in the storage unit.

Amended independent Claims 28 and 32 are system and program claims, respectively, that substantially corresponds to Claim 20.

The applied art is not seen to disclose or to suggest the features of Claim 20 and 28, and in particular is not seen to disclose or to suggest at least the feature of receiving status of use of at least one consumable used in a printing device via a communication line by a server function, calculating a service point according to the received status, causing a storage unit to record information on a customer's purchase of merchandise provided by a consumable trader, the purchase being based on the calculated service point, and deciding a compensation to the consumable trader based on the information recorded in the storage unit.

Malone merely discloses a globally accessible network (Internet) which facilitates access to information located at different server sites, where the system can be used in e-commerce applications. Thus, while Malone may include a root server and a plurality of servers and clients that communicate to access information, it fails to disclose the claimed features of the present invention and the Office Action admits as much.

Specifically, the Office Action admits that "Malone does not specifically recite the various processing steps," but alleges that the claimed steps are common knowledge. However, as pointed out in Applicant's prior response, the Office Action merely made a bald assertion that the claimed process is "common knowledge" that would have been obvious to include in Malone's Internet communication system, without providing any factual evidence to support such a conclusion. Therefore, the rejection fails to meet the legal requirements to show obviousness under 35 U.S.C. § 103(a).

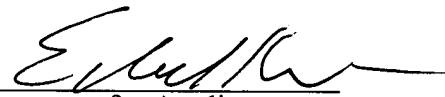
In this regard, as correctly stated at MPEP 2144.03: "It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection is based." citing *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002); *In re Zurko*, 258 F.3d 1379, 1385, 15 USPQ2d 1693, 1697 (Fed. Cir. 2001)(holding that general conclusions concerning what is "basic knowledge" or "common knowledge" to one of ordinary skill in the art without

specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection.) Thus, the grounds for the rejection are improper. Should the Examiner believe that the claimed process steps are still within the "common knowledge" of those skilled in the art, then he is respectfully requested to provide factual evidence to support such an assertion. Otherwise, the Examiner is requested to withdraw the rejection and pass the application to issue.

In view of the foregoing amendments and remarks, the entire application is believed to be in condition for allowance and such action is respectfully requested at the Examiner's earliest convenience.

Applicant's undersigned attorney may be reached in our Costa Mesa, California office by telephone at (714) 540-8700. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

  
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